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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/781,917	02/20/2004	Tohru Horio	248233US2	5308
22850 7590 09/05/2008 OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER MCCULLOUGH, MICHAEL C				
ART UNIT 3653		PAPER NUMBER		
NOTIFICATION DATE 09/05/2008		DELIVERY MODE ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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### Office Action Summary

**Application No.**

10/781,917

**Applicant(s)**

HORIO, TOHRU

**Examiner**

MICHAEL C. MCCULLOUGH

**Art Unit**

3653

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 June 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-45 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-45 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF/ICE)  
Paper No(s)/Mail Date 8/12/2008
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

The amendment filed 3 June 2008 has been entered.

#### ***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

1. Claims 1-12, 14-26, 28-40, 42-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jacobson et al. (US 5,924,686) in view of Sashida (US 6,788,440 B1). Jacobson et al. discloses a sheet pick-up device/means for picking (36) that is a roller, pull-out rollers (46), a drive device/means for driving (47), a detecting device/means for detecting (50), a control device/means for controlling (49) that changes the speed based on a detection result (see column 7 line 54 through column 8 line 22), means for forming an image (12), the control device measures the drive amount (see column 7 line 54 through column 8 line 22) and changes the speed if the detecting device does not detect a leading edge and if the drive amount exceeds a threshold (see column 8 lines 5-22), a display device (see column 9 lines 52-57) that displays information if a threshold is exceeded. Jacobson et al. does not disclose an image reading device/means for reading an image and a sheet separating device/means for separating comprising a rotary member/means for feeding and a roller/means for obstructing feeding, a second detecting device/second means for detecting. However, Sashida discloses a similar device that includes an image reading device/means for reading an image (400) and a sheet separating device/means for separating comprising a rotary member/means for feeding (221) and a roller/means for

obstructing feeding (261), a first and second detecting device/first and second means for detecting (S1 and S2) for the purposes of duplicating an image (see column 7 lines 12-21), separating and conveying an original or only the uppermost one of a plurality of originals (see column 6 lines 22-29), detecting leading edges before separating (see column 8 lines 63-65) and leading edges after separating (see column 9 lines 9-13). It would have been obvious for a person of ordinary skill in the art at the time of the applicant's invention to modify Jacobson et al. by utilizing an image reading device/means for reading an image and a sheet separating device/means for separating comprising a rotary member/means for feeding and a roller/means for obstructing feeding, a second detecting device/second means for detecting, as disclosed by Sashida, for the purposes of duplicating an image, separating and conveying an original or only the uppermost one of a plurality of originals, detecting leading edges before separating and leading edges after separating.

2. Claims 13, 27, and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jacobson et al. (US 5,924,686) in view of Sashida (US 6,788,440 B1), as applied to claims 1-9, 12, 14-23, 26, 28-37, 40, 42-45 above, in farther view of Hamamoto et al. (US 6,421,581 B1). Jacobson et al. in view of Sashida discloses all of the limitations of the claims but does not disclose a pulse motor. However, Hamamoto et al. discloses a similar device that includes a pulse motor (34) for the purpose of controlling the feeding of a sheet (see column 6 lines 13-35). It would have been obvious for a person of ordinary skill in the art at the time of the applicant's invention to

modify Jacobson et al. in view of Sashida by utilizing a pulse motor, as disclosed by Hamamoto et al., for the purpose of controlling the feeding of a sheet.

### ***Response to Arguments***

Applicant's arguments filed 3 June 2008 have been fully considered but they are not persuasive.

3. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).
4. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL C. MCCULLOUGH whose telephone number is (571)272-7805. The examiner can normally be reached on Monday-Friday, 7:00 am - 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Mackey can be reached on (571) 272-6916. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Patrick H. Mackey/  
Supervisory Patent Examiner, Art  
Unit 3653

MCM